

REMARKS

The Applicant has carefully reviewed and considered the Office Action of 16 June 2005. In response the Applicant amends claim 1 to incorporate the subject matter of original claim 2. Claim 2 is canceled without prejudice. Claims 3-7 are amended to depend from claim 1. Claims 8-25 are maintained in their original form. Finally, claims 26-36 are withdrawn from consideration and the Applicant hereby affirms the previously made election to invention I, claims 1-25, drawn to a product, classified in class 442, subclass 364.

Turning now to the substantive issues, it is very clear that amended claims 1 and 3-25 patentably distinguish over EP 0465203 A1 to Nielsen et al. even when considered in combination with DE 19804418 A1 further evidenced by Weinle et al. (U.S. 4,840,832) and Sandstrom et al. (U.S. 6,379,497).

Among other features, amended claim 1 of the present application provides that a portion of the plurality of structural fibers comprises one or more irregularly shaped fibers having a melting point significantly higher than the outer polymer annulus. The references cited by the Examiner fail to provide a *prima facie* case of obviousness to support a rejection of this claim.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Significantly, it is noted in MPEP section 2143, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

As further noted by the Court in *In re Rouffet*, , 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998), "[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art and the knowledge of persons of ordinary skill in the art." If these principles are properly applied in the instant case, it is clear that the cited references fail to provide a proper basis to support a rejection.

The present invention relates to surfacing veils. As noted in paragraph 2 of the present application, "surfacing veils help prevent print-through of contours of the bundles of reinforcing fibers that lay beneath the surface." As noted in paragraph 5, glass surfacing veils disadvantageously have difficulty conforming to complex shapes. The glass fibers themselves do not elongate significantly under stress. If a glass-surfacing veil is placed in a recessed region with compound curvature, the glass veil will likely form a crease. Further, if glass veils are placed over a protruding region such as a boss, the lack of elongation will likely cause the surfacing veil to tear. By definition, glass-surfacing veils must provide a desired surface appearance (see also paragraph 7 of the present application).

EP '203 to Nielsen et al. is the primary reference in the rejection that has been formulated by the Examiner. The Nielsen et al. patent refers to a wet laid web containing (a) a bicomponent fiber having a polyester or polyamide fiber component and a linear low-density polyethylene component and (b) a matrix fiber made, for example, from glass fibers or polyester fibers. As acknowledged by the Examiner on page 4 of the Office Action, the primary reference to Nielsen et al. is "... silent to the use of irregular shaped fibers."

In order to address this shortcoming of the Nielsen et al. patent, the Examiner cites DE '418. The DE '418 reference relates to a padded underlay for use with decorative and/or cladding material. While it is true that the reference refers to the utilization of polyester fibers with a spiral crimp, the Applicant does not agree that it "would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the matrix fibers of Nielsen et al. and provide them with an irregular shape with the motivation of providing bulk and a structured appearance as disclosed by the DE '418 reference." Significantly, the DE '418 reference relates to a padded underlay and not a surfacing veil. One skilled in the art seeking to invent a new surfacing veil is critically concerned with surface appearance, and would not refer to the padded underlay art for any relevant teaching or suggestion. Certainly neither the Nielsen et al. patent nor the DE '418 reference teach or suggest that spiral fibers won't print through resin thereby marring the appearance of the surfacing veil and rendering it useless. In other words, the cited references fail to teach or

suggest that irregularly shaped fibers are appropriate for use in a surfacing veil given the unique surface requirements for such a veil.

"Whether a particular combination might be 'obvious to try' is not a legitimate test of patentability." See a long line of cases including *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Geiger*, 2 USPQ2d 1276 (Fed. Cir. 1987), and *In re Goodwin*, 198 USPQ1 (CCPA 1978). As noted in MPEP section 2143.01, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." In the present case, the primary reference to Nielsen et al. gives no indication or suggestion that irregularly shaped fibers could be utilized in a surfacing veil. The secondary reference, DE '418, relates to a padded underlay and also fails to provide this teaching or suggestion. In this light, it is clear that the only source of suggestion for combining the references in the manner proposed by the Examiner is found in the present application. It, of course, is well established that it is error to use the teachings and suggestions of the present application as a guide in combining references to establish an obviousness rejection. See *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Int. 1985). Thus, it is clear that no *prima facie* case for obviousness has been established and, therefore, claim 1 patentably distinguishes over the cited prior art and should be allowed.

Claims 3-25 which depend from claim 1 and are rejected on the same grounds are equally allowable for the same reasons.

With regard to claim 8, the additional reliance of the Examiner on U.S. Patent 6,379,497 to Sandstrom et al. fails to save the rejection. More particularly, claim 8 reads on a surfacing veil further comprising about 5 to 20 weight percent microspheres. The primary reference EP '203 to Nielsen et al. fails to teach or suggest the concept of incorporating microspheres into a wet laid web. Microspheres are also not mentioned in the abstract of DE '418. While the Sandstrom et al. '497 reference refers to microspheres, the disclosure in Sandstrom et al. is limited to microsphere use in cellulosic paperboard products.

None of the cited references teach or suggest the use of microspheres in a surfacing veil as set forth in present claim 8. Further, none of the cited references in any way suggest to one skilled in the art that microspheres could be utilized in a surfacing veil. Since microspheres expand upon heating, absent teachings to the contrary, one skilled in the art might expect microspheres to expand upon molding and print through the surfacing veil thereby producing an unusable product. There simply is no motivation in the cited references to lead one skilled in the art to utilize microspheres in a surfacing veil in the manner set forth in claim 8 and, accordingly, claim 8 should be allowed.

Claims 19 and 23 both refer to a surfacing veil wherein the outer polymer annulus comprises a low melt copolymer polypropylene. As acknowledged by the Examiner, the primary reference to Nielsen et al. fails to teach this concept. Similarly, polypropylene is not mentioned in the abstract of the DE '441 patent.

As a result the Examiner relies upon U.S. Patent 4,840,832 to Weinle et al. for this teaching.

It should be noted, however, that the Weinle et al. patent does not relate to surfacing veils and, accordingly, does not address the shortcomings noted above with respect to the failure of the primary reference to Nielsen et al. and the secondary DE '418 patent to teach or suggest the use of irregularly shaped fibers in surfacing veils. Accordingly, the cited references, even when considered in combination, fail to provide a proper basis for the rejection of claims 19 and 23 which should be allowed.

The Examiner objected to the IDS recently submitted by Applicant for failing to include copies of the foreign references. Applicant is therefore submitting a new IDS to overcome this objection.

In summary, all the pending claims patentably distinguish over the prior art and should be formally allowed. Upon careful review and consideration it is believed the Examiner will agree with this proposition. Accordingly, the early issuance of a formal Notice of Allowance is earnestly solicited. The Commissioner is hereby authorized to charge any fees required to Deposit Account No. 500568 in connection with this Amendment.

Respectfully submitted,

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